

40009-0002

10/798,619

REMARKS

This is a full and timely response to the final Official Action mailed February 13, 2006.

Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Original claims 19 and 20 have been cancelled previously without prejudice or disclaimer. Thus, claims 1-18 and 21 are currently pending for further action.

35 U.S.C. § 112, second paragraph:

The recent Office Action rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Action, “[i]t is not clear whether applicant is intending to structurally claim the inner and outer rings or not.” (Action of 2/13/07, p. 2). This is unreasonable.

Apparently, the Examiner has not read claim 5 in its current form. Claim 5, as reproduced above, was amended some time ago and the behest of the Examiner to explicitly and affirmatively recite that “said socket comprises inner and outer rings.” Thus, the rejection of claim 5 under 35 U.S.C. § 112, second paragraph, is completely inappropriate and should not be sustained.

40009-0002

10798,619

Prior Art:

In the Office Action, claims 1 and 4-6 were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent App. Pub. No. 2004/0116045 to Coleman ("Coleman"). For at least the following reasons, this rejection is traversed.

Claim 1 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:

a vibratory member configured to be vibrated by the spokes of a rotating wheel; and

a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;

wherein said identity plate further comprises one or more panels bearing identification indicia or decorative elements, said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle.

(emphasis added).

In contrast, Coleman utterly fails to teach or suggest the claimed subject matter including one or more panels "bearing identification indicia or decorative elements, said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle."

In this regard, the Examiner argues that "the recitation 'said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle' is functional in nature and does not introduce any

40009-0002

10/798,619

added structural limitations The Applicant must distinguish over the prior art with structural limitations." (Action of 2/13/07, p. 7). This is both legally and technically incorrect.

In the first place, the position taken by the Examiner blindly ignores the fact that the functional language used necessarily dictates features of the structure used to perform that function. The MPEP expressly states that "features of an apparatus may be recited either structurally or functionally." (MPEP § 2114). As claimed, Applicant's device includes structure that provides "identification indicia or decorative elements on said vehicle [that] can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle." This claim language *cannot* be ignored by a reasonable and fair patent examiner.

The Examiner goes on to argue, incorrectly, that "Coleman is capable of performing the intended function." (Action of 2/13/07, p. 7). Coleman is *not* capable of performing as does the claimed invention. The Office Action utterly fails to identify any panel or other portion of the Coleman device that both bears identification indicia and can be replaced without removing a supporting main body from the vehicle as claimed. In fact, the Office Action fails to even indicate what element of the Coleman device is thought to be read on by the claimed "one or more panels." Rather, the Action unhelpfully cites a portion of Coleman, paragraph 0056, which states, in its entirety, the following: "The flapper mount assembly and bicycle mounting clamp enclosure assembly of the device may have other graphic treatments such as pictures, designs, patterns, geometric or non-geometric shapes, trademarks of branded products, team logos, decals, etc. added to the surface to enhance the appearance of the accessory or for advertising purposes." (Action of 2/13/07, p. 3). The Office Action then fails to make any connection between this general teaching that graphic treatments may be applied to the Coleman device and the element

40009-0002

10/798,619

of Coleman, if any, that is thought to correspond to the claimed one or more panels recited by Applicant. In this way, the Action fails to make out a *prima facie* case of unpatentability based on Coleman.

Because the Coleman device does not and cannot perform as does Applicant's claimed invention, it is inescapable that the structure of Coleman is *not* equivalent to the structure called for by Applicant's claims. Clearly, Coleman does not teach or suggest "one or more panels bearing identification indicia or decorative elements, said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel." Coleman does not teach or suggest that claimed "said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claim 1 and its dependent claims based on Coleman should not be sustained.

Claim 5 recites: "wherein said socket comprises inner and outer rings; and *said vibratory member comprises a round base* that is configured to snap fit between said inner and outer rings of said socket." (Emphasis added). In this regard, the Office Action refers to the flapper assembly (50) taught by Coleman. However, this flapper assembly does not have the claimed

40009-0002

10/798,619

"round base" where the round base "is configured to snap fit between said inner and outer rings of said socket." There is no such structure taught or suggested by Coleman. Therefore, for at least this additional reason, the rejection of claim 5 should not be sustained.

Claim 6 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:

a vibratory member configured to be vibrated by the spokes of a rotating wheel; and

a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;

wherein said vibratory member is configured to snap into a socket on said main body at any of a variety of angles *with respect to said main body* so as to accommodate differently sized bicycles.

(Emphasis added).

In contrast, the recent Office Action completely misses the fact that the recited vibratory member and socket cooperate such that the "vibratory member is configured to snap into a socket on said main body at any of a variety of angles *with respect to said main body.*" (Emphasis added). In a completely irrelevant argument, the Office Action cites paragraph 0055 of Coleman which states that "the flapper may extend farther or not as far into the path of the spokes, or the flapper may be placed closer or very near either the center of the wheel or the outer edge of the rim near the tire." This has absolutely nothing to do with reorienting the vibratory member into any of a variety of angles *with respect to the main body* that supports the vibratory member. Once again, the Action fails to provide a reasonable response to Applicant's claim and fails to make a *prima facie* case of unpatentability as to claim 6. For at least these reasons, the rejection of claim 6 and its dependent claims should be reconsidered and withdrawn.

40009-0002

10/798,619

Claims 2, 3 and 7-18 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of Coleman taken alone. For at least the following reasons, these rejections are respectfully traversed.

Claim 7 recites: "The accessory of claim 6, further comprising notches disposed around a periphery of said socket for receiving tabs disposed around a periphery of said vibratory member, said notches corresponding to said variety of angles." As demonstrated above, Coleman does not teach or suggest the ability to dispose the vibratory member in any of a variety of angles *with respect to the supporting main body*. Consequently, Coleman further cannot teach or suggest the claimed notches disposed around a socket corresponding to that variety of angles at which the vibratory member can be attached to accommodate differently sized bicycles. For at least these additional reasons, the rejection of claim 7 should not be sustained.

Claim 8 recites: "wherein said accessory comprises three points at which said accessory is attached to a bicycle." In this regard, the Office Action unreasonably indicates three holes (59) taught by Coleman which are used to mount the flapper (52) to the straight pieces of a flapper assembly (50). (Action of 2/13/07, p. 9). This is irrelevant to the claimed three points at which the claimed *accessory* is attached to a *bicycle*. If attention is paid to what Applicant is actually claiming, it becomes clear that the teachings of Coleman cited by the Office Action have no relevance to claim 8. Rather, Coleman does not teach or suggest the three point attachment scheme recited in claim 8, and rejection of claims 8 and 9 should not be sustained.

40009-0002

10/798,619

Claim 10 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:

a vibratory member configured to be vibrated by the spokes of a rotating wheel; and

a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;

wherein said main body comprises an attachment point comprising a plurality of holes disposed around a periphery of a protrusion such that a zip tie can be threaded through said holes at a plurality of angles with respect to said main body.

(emphasis added).

In this regard, the Office Action again points to the same three holes (59) cited above that are used to connect the flapper (52) to the flapper assembly (50). (Action of 2/13/07, p. 9). As any reasonable person can see from Fig. 2 of Coleman, these holes are *not* in a "main body" of the Coleman device that supports the vibratory member on the vehicle. Consequently, these holes (56) cannot be the holes recited in claim 10. Moreover, any reasonable person can see from Fig. 2 of Coleman that these holes (59) would not, and are not intended to, accommodate a zip tie as claimed. For at least these reasons, the rejection of claim 10 should not be sustained.

Claim 16 recites:

A packaged kit comprising:

an accessory for a vehicle having a wheel with spokes, said accessory comprising;

a vibratory member configured to be vibrated by the spokes of a rotating wheel; and

a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate; and

a variety of identification indicia or decorative elements that can be selectively disposed on said identity plate.
(emphasis added).

40009-0002**10/798,619**

In contrast, Coleman does not teach or suggest the claimed packaged kit that includes an identity plate and "a variety of identification indicia or decorative elements that can be selectively disposed on said identity plate."

Applicant again notes that, where the examiner relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejection of claim 16 and its dependent claims should not be sustained.

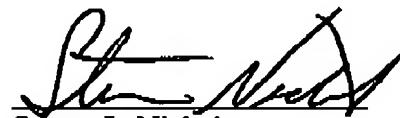
40009-0002

10/798,619

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,


Steven L. Nichols
Registration No. 40,326

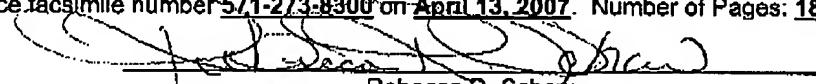
DATE: April 13, 2007

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on April 13, 2007. Number of Pages: 18


Rebecca R. Schow